

**REMARKS**

Claims 1-21 are pending in this application. Claims 1-21 are rejected. Claims 1-5, 13, 16-19 and 21 have been amended. Claims 22-24 have been added. Claims 1-24 are now pending. Reconsideration of the claims is requested in light of the following remarks.

**Claim Objections**

Claim 1 is objected to because the term "a e-mail sender" in line 4 is improper and suggests changing it to "an e-mail sender." Applicants thank the Examiner for the correction and amended the claim to correct this error.

**Claim Rejection – 35 USC § 103**

Henry: Claims 1, 2, 5-8, 10, 13-18 and 21

Claims 1, 2, 5-8, 10, 13-18 and 21 are rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 6,424,426 to Henry ("Henry"). Applicants respectfully disagree according to the following

Claim 1 now requires:

- a fax gateway including,
- a storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient through a packet switching network, the stored e-mail message to be converted to a fax document for transmission thereof to fax recipient having access to a fax device;
- at least one fax modem device for transmitting the fax document to the fax recipient through a public switching network,
- wherein a fax number designating the fax recipient is not contained in the e-mail message.

Henry discusses a fax-to-email and email-to-fax communication system and method providing a user the ability to send emails from any standalone facsimile machine and providing a user the ability to logon to a centralized web server and send facsimiles to any standalone fax machine. Applicants agree with the examiner that Henry fails to explicitly teach the ARPA-Internet Network Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment. However, Henry teaches that the fax recipient's fax number is either contained in the email or has a designator in the email to direct an address book to insert the recipients fax number.

The pending claim 1 explicitly requires that the fax number designating the fax recipient is not contained in the email message. Since Henry fails to teach or suggest all the claim limitations, claim 1 is patentably distinguishable over the cited reference and allowance

of this claim is requested. Claims 2, 5-8, 10, 13-16 depend from claim 1. Since dependent claims necessarily contain the limitations of claims from which they depend, claims 2, 5-8, 10, 13-16 are also patentably distinguishable over Henry and allowance of these claims is requested.

Claims 17, 18 are method claims with a similar limitation to device claim 1 and is therefore distinguishable over Henry, and claim 21 is a Beauregard claim with a similar limitation as in claim 1 and is therefore distinguishable over Henry. Specifically, claims 17, 18 and 21 require transmission to a fax recipient *"without extracting a fax number from the e-mail message"*. Claims 17, 18 and 21 are therefore patentably distinguishable over Henry and allowance of these claims is requested.

Henry in view of Toyoda: Claims 19 and 20

Claims 19 and 20 are rejected under 35 USC 103(a) as being unpatentable over Henry in view of U.S. Pat. No. 5,812,278 to Toyoda et al. ("Toyoda").

As mentioned above, Henry discusses a fax-to-email and email-to-fax communication system and method providing a user the ability to send emails from any standalone facsimile machine and providing a user the ability to logon to a centralized web server and send facsimiles to any standalone fax machine. Applicants agree with the examiner that Henry fails to explicitly teach the ARPA-Internet Network Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment. However, Henry teaches that the fax recipient's fax number is either contained in the email or has a designator in the email to direct an address book to insert the recipients fax number.

Toyoda discusses an image communicating method, facsimile type electronic mail apparatus and facsimile apparatus in which a communication between a transmitting side and a receiving side is performed even though a paper size treated on the transmitting side differs from that treated on the receiving side.

Toyoda fails to teach or suggest transmission to a fax recipient *"without extracting a fax number from the e-mail message"*. Toyoda therefore fails to cure at least this deficiency of Henry. Claims 19 and 20 depend from claim 17. Therefore, since dependent claims necessarily contain the limitations of claims from which they depend, claims 19 and 20 are also patentably distinguishable over Henry, even in view of Toyoda, and allowance of these claims is requested.

Henry in view of Owens: Claim 9

Claim 9 is rejected under 35 USC 103(a) as being unpatentable over Henry in view of U.S. Pat. No. 6,633,630 to Owens et al. ("Owens").

As already mentioned, Henry discusses a fax-to-email and email-to-fax communication system and method providing a user the ability to send emails from any standalone facsimile machine and providing a user the ability to logon to a centralized web server and send facsimiles to any standalone fax machine. Applicants agree with the examiner that Henry fails to explicitly teach the ARPA-Internet Network Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment. However, Henry teaches that the fax recipient's fax number is either contained in the email or has a designator in the email to direct an address book to insert the recipients fax number.

Owens discusses a system for integrated electronic communications, and in particular for integrating electronic mail, voice mail, and fax mail in a universal mailbox. Furthermore, message receivers may access their messages with a telephone or a computer regardless of the communication medium used by the message sender.

Owens fails to teach or suggest transmission to a fax recipient where "a fax number designating the fax recipient is not contained in the e-mail message". Owens therefore fails to cure at least this deficiency of Henry. Claim 9 depends from claim 1. Therefore, since dependent claims necessarily contain the limitations of claims from which they depend, claim 9 is also patentably distinguishable over Henry, even in view of Owens, and allowance of this claim is requested.

Henry in view of Gidwani: Claims 11 and 12

Claims 11 and 12 are rejected under 35 USC 103(a) as being unpatentable over Henry in view of U.S. Pat. No. 6,640,239 to Gidwani ("Gidwani").

As explained above, Henry discusses a fax-to-email and email-to-fax communication system and method providing a user the ability to send emails from any standalone facsimile machine and providing a user the ability to logon to a centralized web server and send facsimiles to any standalone fax machine. Applicants agree with the examiner that Henry fails to explicitly teach the ARPA-Internet Network Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment. However, Henry teaches that the fax recipient's fax number is either

contained in the email or has a designator in the email to direct an address book to insert the recipients fax number.

Gidwani discusses an apparatus and method for an intelligent scalable switching network that provides a unified Internet portal server having multi-line capability, and a unified Internet portal client incorporating functionality of a DSL modem.

Gidwani fails to teach or suggest transmission to a fax recipient where "a fax number designating the fax recipient is not contained in the e-mail message". Gidwani therefore fails to cure at least this deficiency of Henry. Claims 11 and 12 depend from claim 1. Therefore, since dependent claims necessarily contain the limitations of claims from which they depend, claims 11 and 12 are also patentably distinguishable over Henry, even in view of Gidwani, and allowance of these claims is requested.

Henry in view of Toyoda 505: Claims 3 and 4

Claims 3 and 4 are rejected under 35 USC 103(a) as being unpatentable over Henry in view of U.S. Pat. No. 5,825,505 to Toyoda et al ("Toyoda 505").

As already mentioned, Henry discusses a fax-to-email and email-to-fax communication system and method providing a user the ability to send emails from any standalone facsimile machine and providing a user the ability to logon to a centralized web server and send facsimiles to any standalone fax machine. Applicants agree with the examiner that Henry fails to explicitly teach the ARPA-Internet Network Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment. However, Henry teaches that the fax recipient's fax number is either contained in the email or has a designator in the email to direct an address book to insert the recipients fax number.

Toyoda 505 discusses an image communication apparatus including a reader for reading an original image, a communication unit including an NCU for transmitting and receiving image data through a subscriber line, a recorder for recording the image read by the reader and the image data received by the communication unit on a recording paper, a CPU for controlling an overall operation of the image communication apparatus, and contacts for connecting a detachable auxiliary or external device so that the CPU has an auxiliary function of the image communication apparatus.

Toyoda 505 fails to teach or suggest transmission to a fax recipient where "a fax number designating the fax recipient is not contained in the e-mail message". Toyoda 505 therefore fails to cure at least this deficiency of Henry. Claims 3 and 4 depend from claim 1.

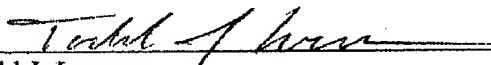
Therefore, since dependent claims necessarily contain the limitations of claims from which they depend, claims 3 and 4 are also patentably distinguishable over Henry, even in view of Toyoda 505, and allowance of these claims is requested.

**CONCLUSION**

For the foregoing reasons, reconsideration and allowance of claims 1-24 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Todd J. Iverson

Reg. No. 53,057

MARGER JOHNSON & McCOLLOM, P.C.  
210 SW Morrison Street, Suite 400  
Portland, OR 97204  
503-222-3613  
Customer No. 20575

I hereby certify that this correspondence  
is being transmitted to the U.S. Patent and  
Trademark Office via facsimile number  
(571) 273-8300, on August 9, 2005.

Submitted:

  
Judy Wigmore